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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte WILLIAM KRESS BODIN, MICHAEL JOHN
BURKHART, DANIEL G. EISENHAUER, DANIEL MARK
SCHUMACHER, and THOMAS J. WATSON

_____

Appeal 2009-004171
Application 10/734,764
Technology Center 2100

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Decided: January 28, 2010

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Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and JAMES
R. HUGHES, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's Final

Rejection of claims 1-24. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Invention

Appellants' invention comprises:

> Creating a presentation document that include creating, in dependence upon an original document, a structured document comprising one or more structural elements and creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes a structural element identifier for at least one structural element of the structured document.

(Spec. 56, Abstract; Figs. 3 and 4).

Representative Claim

1. A method for creating a presentation document, the method comprising:

creating, in dependence upon an original document, a structured document comprising one or more structural elements; and

creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes a structural element identifier for at least one structural element of the structured document.

Prior Art and Examiner's Rejections

The Examiner relies on the following references as evidence of anticipation and unpatentability:

Raman	US 5,748,186	May 05, 1998
Josephson	US 2003/0023435 A1	Jan. 30, 2003

Claims 1-7, 9-15, and 17-23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Raman. This reference and Josephson are utilized by the Examiner to reject claims 8, 16, and 24 under 35 U.S.C. § 103(a).

Claim Grouping

Based on Appellant's arguments in the Appeal Brief, we will decide the appeal on the basis of independent claim 1 as representative of the subject matter of independent claims 1, 9, and 17. Within the rejection under 35 U.S.C. § 102(b), no dependent claims are argued. Additionally, the rejections of various claims under 35 U.S.C. § 103(a) will be treated separately.

ISSUE

Have Appellants shown that the Examiner erred in finding that Raman teaches creating "a presentation grammar" as set forth in representative independent claim 1 on appeal?

FINDINGS OF FACT ("FF")

1. In responding to Appellants' arguments in the Brief, the Examiner sets forth at pages 12-14 of the Answer this response:

    Independent claim 1 describes:

    > *A method for creating a presentation document, the method comprising:*
    > *creating, in dependence upon an original document, a structured document comprising one or more structural elements; and creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which*

*includes a structural element identifier for at least one
structural element of the structured document.*

The claim deals with the creation of a presentation
document. Raman teaches a multimodal presentation system
(title). He creates a presentation document as can be seen in fig
3. The claim further describes that a structured document which
already contains structural elements (thus that is the reason why
it is a structured document) is created from an original
document. See, Raman, col. 2, lines 18-35, col. 3, lines 6-1 1 &
abstract, teaching retrieving a document and converting the
information to a "common intermediate representation" with a
structure of the information. Thus he converts an original
document to a structured format.

Then the claims describe creation of a presentation
grammar associated with the structured document. This
presentation grammar includes grammar elements with
identifiers. Raman already discusses the use of presentation
grammar by teaching that control signals can include
recognized speech (Raman, col. 6, lines 29-31). He then further
states in column 3, lines 30-35 "..a voice input unit coupled to
a speech recognizer, and <u>a speech synthesizer</u>." Thus Raman
shows that the speech is tied to structured grammar components
by using a speech synthesizer. Skilled artisan would realize that
a speech synthesizer is for the purpose of conversion between
text and speech. Thus by converting speech to textual elements,
Raman creates a presentation grammar. Such a presentation
grammar is created by converting the speech to textual elements
in the structured document as discussed in column 5, lines 48-
67 and shown in figures 2-4. Furthermore it can be seen that
every component in a structured document is already identified
(see fig 3). For Example the synthesizer converts the speech
into a textual format it is described in a structured document
with associated identifiers shown in fig 3 using tags such as
<title>, <address> etc.. Raman invention deals with
presentation systems and he ties in presentation grammar by
converting speech to text using a synthesizer, he further uses
this text for his presentation system which is already in
structured format thus including identifiers.

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(Ans. 12-14).

2.   Raman's abstract teaches:

In a computer system, a method is implemented for
interactively presenting electronically encoded multi-media
information. The information including marks to indicate a
structure of the information. The method includes the steps of
receiving the information, and converting the information to a
common intermediate representation stored in a memory of a
computer system in the form of a hierarchical attribute tree.
The tree has a plurality of document objects, the document
objects represent the information, the structure of the
information, and procedures which can operate on the
information. The common intermediate representation is
presented using a plurality of user communication modalities
according to the hierarchical attribute tree. While presenting
the information, the method receives control signals from a user
using the plurality of user communication modalities to enable
the user to interactively and independently control the receiving
of the information and the presentation of the information in a
plurality of presentation modalities.

3.   Raman teaches at column 1, lines 25-38, that hyper-text and
HTML are known:
        A standard encoding scheme for multi-media information
uses what is known as "hyper-text markup language."
Information encoded according to this standard is easily
recognized by the file postfix designation ".html,". This
designation is familiar to users of WWW retrieval and
presentation systems such as Netscape, and Mosaic.
        Hyper-text includes "marks" which define the structure
of the information in the source document. For example, the
text may include structural marks which indicate headers, titles,
sections, paragraphs, "bullets," and so forth. The marks are
used to visually format the information while it is being
presented. For example, section headers may be bolded and
paragraphs can be separated by line breaks and indentations.

4.   In making reference to the block diagram structures of Figure 1,
Raman teaches at column 4, lines 45-51 the following:

> The recognizer 130 parses the character stream into
> fundamental source elements, for example, title, sections, sub-
> sections, paragraphs, sentences, links, and forms, and so forth.
> The elements are stored in the intermediate high-level data
> structure 200. Variations in writing styles, and ambiguities in
> the use of the markup language make the extraction of the high
> level structure 200 difficult.

This data structure is illustrated in Raman's Figures 2 and 3.

PRINCIPLES OF LAW

Anticipation

"A claim is anticipated only if each and every element as set forth in
the claim is found, either expressly or inherently described, in a single prior
art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d
628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over
the prior art under 35 U.S.C. § 102 begins with a determination of the scope
of the claim. We determine the scope of the claims in patent applications
not solely on the basis of the claim language, but upon giving claims their
broadest reasonable construction in light of the specification as it would be
interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech.
Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim
must then be compared with the prior art.

ANALYSIS

As noted by the Examiner at page 12 of the Answer, the Appeal Brief
essentially argues that Raman doesn't teach the concept of "a presentation

grammar." No other feature of representative claim 1 is argued. The Examiner's extensive remarks in the FF 1 further embellishes upon the Examiner's views as to the corresponding teachings not only of the creation of the structured document feature of the representative independent claim 1 on appeal, but upon the recited creating "a presentation grammar" feature of that claim as well. We agree.

With respect to the Examiner's reliance upon the speech recognizer and speech synthesizer teachings in Raman, Appellants make mention at pages 8 and 11 of the Brief that well-known dictation systems include such technology, but in Appellants' view, do not include capabilities for discerning grammar. On the contrary, it is the dictator or the user of these systems that instructs the dictation systems where to place paragraphs, titles, periods, and the like, all of which constitute a broadly defined "a presentation grammar" to the extent recited in the claims.

Independent of these views, Raman's abstract in FF 2 clearly indicates that Raman's teachings relate to the encoding of multi-media information such as to include marks to indicate a structure of the information and that an object-oriented approach includes document objects representing the information as well as the structure of the information itself. Moreover, the abstract further reveals that various modalities, which may be broadly construed as grammar-like, additionally teach the capability of the broadly defined "a presentation grammar" of representative independent claim 1 on appeal.

Additionally, we make reference to FF 3 and 4. These findings clearly indicate that the well-known HTML encoding techniques include encoding for not only content of an original document, but also structural elements.

The structural elements indicate the manner in which this information will be presented including headers, titles, sections, paragraphs, bullets, and so forth. These are illustrated in a tree-structured approach in Figure 2 of Raman, and are additionally relied on by the Examiner in the marked-up hypertext document of the original document in Figure 3.

Thus, a person of ordinary skill in the art would understand Raman to teach different and multiple aspects that relate to the broadly defined "a presentation grammar" as required by independent claim 1 on appeal, including grammar elements and structural element identifiers.

Pages 8-11 of the Brief take the position that Raman does not provide enabling disclosure sufficient to place a person of ordinary skill in the art in possession of each element of the claimed subject matter. Again, the focus of the arguments is that there is no enabling disclosure of presentation grammar in Raman. On the contrary, presentation grammar is clearly disclosed to a person of ordinary skill in the art as demonstrated by the Examiner's responsive arguments in FF 1, as well as our extensive reliance upon FF 2-4 as explained earlier in this opinion. Raman relies upon well-known HTML formatting techniques for documents within this patent's filing date of October 2, 1995. Additionally, Appellants present no independent evidence that Raman is not enabled, merely attorney arguments to that effect. One of ordinary skill in the art would understand FF 1-4 to present well-known techniques for structuring documents in a grammar-like manner to the extent broadly recited in representative independent claim 1 on appeal.

These remarks are consistent with our reviewing court's most recent decision, *In re Gleave*, 560 F.3d 1331 (Fed. Cir. 2009). This decision points

out that for method claims, such as representative independent claim 1 on appeal, the make requirement becomes in effect a use requirement. Appellants have not shown by suitable evidence and arguments that Raman would not enable an artisan to use or otherwise practice or carryout what Raman indicates to the reader was well known in the art.

Turning next to the rejection of claims 8, 16, and 24 under 35 U.S.C. § 103(a), pages 12 and 13 of the brief do not argue that the references to Raman and Josephson are not properly combinable within 35 U.S.C. § 103(a). Therefore, no governing case law is cited in this opinion to that effect.

We do not agree with Appellants' urging, at page 13 of the Brief, that the Examiner has not set forth the necessary factual inquiries to establish a prima facie case of obviousness. The Examiner's reasoning at pages 9-11 of the Answer, which sets forth the statement of the rejection of the noted claims, in our view, maps the corresponding requirements of representative dependent claim 8 on appeal to the relevant teachings in Raman, and identifies what Raman does not explicitly teach but that which Josephson expressly teaches. The remarks at page 13 of the Brief do not contest any of these teachings in Josephson and Raman. Instead, Appellants merely allege the Examiner's failure to set forth the necessary factual findings underpinning the rejection.

CONCLUSIONS AND DECISION

Appellants have not shown that the Examiner erred in finding that Raman teaches the broadly recited "a presentation grammar" as recited in representative independent claim 1 on appeal. Additionally, Appellants have not shown that the Examiner erred in the substance and the manner of

presenting evidence of unpatentability as to dependent claims 8, 16, and 24 on appeal. Therefore, we affirm the Examiner's rejections of various claims on appeal under 35 U.S.C. §§ 102 and 103. All claims on appeal are unpatentable.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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